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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,595	12/11/2001	Makoto Tabata	482842000500	4248
25227	7590	11/12/2004	EXAMINER	
MORRISON & FOERSTER LLP 1650 TYSONS BOULEVARD SUITE 300 MCLEAN, VA 22102			VERBITSKY, GAIL KAPLAN	
			ART UNIT	PAPER NUMBER
			2859	

DATE MAILED: 11/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

JPN

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/009,595	TABATA ET AL.	
	<b>Examiner</b> Gail Verbitsky	<b>Art Unit</b> 2859	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 26 August 2004.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 4 and 23-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 4,8 and 24 is/are allowed.
- 6) Claim(s) 23, 25 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____.   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

## DETAILED ACTION

### ***Specification***

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification. The disclosure is objected to because of the following informalities: the limitations including "to a back side of the person" and "a front side of a person", as stated in claim 8 have not been clearly described in the specification. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. Claims 23, 25 are finally rejected under 35 U.S.C. 102(a) as being anticipated by WO 99/04230 [hereinafter Konno].

Konno discloses in Figs. 2 and 7-9, 11 an ear thermometer comprising a main body configured to be held by an operator, a probe attached to the main body and protruding from it and configured to be inserted into an ear canal of a patient, a start measuring switch (indicator surface) 4 located on a substantially curved second side B opposite to a first side A. If to draw a plane C (reference plane) dividing the device into

two symmetrical parts, the plane C will include a center axis D of the probe and also be a center of symmetry of the curved side wherein the curved surface of the curved side will be substantially constant along the length of the plane and perpendicular to the plane C. A center F of the curved surface is in the vicinity of a base G of the probe. The main body comprising an indicator surface/ switch surface 4. The switch surface 4 contains a plurality of surfaces (first surface and second surface) arranged symmetrically with respect to the reference place C, while the reference plane C contains the center axis of the probe D.

It is inherent, as understandable from the figures, that the operator can move his /her hand along the curved surface in order to chose (recognize) a comfortable position out of a plurality holding positions differing according to a direction in which the probe is being inserted (and the position of the patient, i.e., sitting, prone, supine, etc.). It is inherent that a switch serves as at least one indicator relative to which the operator can move the hand and to recognize (realize) where the hand is relative to the switch (indicator). The switch (indicator/ indicator surface) is arranged in the reference plane C that contains the central axis of the probe. It is inherent that, serving as an indicator, the switch 4 will allow the operator to recognize the position of the main body relative to a reference (a finger placed onto the switch). It is also inherent that, dependent on the operator preference the reference can be an index finger of the operator. As shown in Figs. 9 and 11, the switch 4 constructed as a convex portion and arranged on each side relative to the reference plane.

Konno states (col. 13, lines 26-28), that the switch 4 can have any shape (or any number of switches), thus, in a broad sense, suggesting the particular shape for allowing the operator to recognize a holding method (to determine the position of the hand of the operator relative to the switch) by touching the switch 4, as shown in the attachment #2 to the previous Office action. (Also see attachment #1A, attached herein).

For claim 23: as shown in the attachment # 1A, the indicator surface comprises first and second surfaces (two/ plurality) of surfaces arranged substantially symmetrically with respect to a reference plane C that contains a center axis of the probe.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

#### ***Allowable Subject Matter***

5. Claims 4, 8 and 24 are allowed.

#### ***Response to Arguments***

6. Applicant's arguments filed on August 26, 2004 have been fully considered but they are not persuasive. Applicant states that the switch of Konno cannot be viewed as a plurality of surfaces arranged substantially symmetrically with respect to a reference plane containing a center axis of the probe. In response to this argument, please refer to the attachment # 1 to the previous Office Action wherein the switch surface comprising two (plurality of) surfaces, which are symmetrical to each other with respect to the reference plane C, while the reference plane C contains the center axis D. Also, see the attachment # 1A for additional explanations of rejection of claims 23 and 25.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to the Examiner Verbitsky who can be reached at (703) 306-5473 Monday through Friday 7:30 to 4:00 ET.

Any inquiry concerning this communication should be directed to the group receptionist whose telephone number is 571/ 272-2253.

GKV

November 04, 2004

*Gail Verbitsky*

*Primary Patent Examiner, TC 2800*

